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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/745,923

12/22/2000

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42390P9432

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08/25/2004

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EXAMINER

TRINH, TAN H

ART UNIT

PAPER NUMBER

2684

DATE MAILED: 08/25/2004

14

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/745,923

Applicant(s)

TOU ET AL. +

Examiner

TAN TRINH

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 11-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Kaschke (U.S. Patent no. 5,898,933).

Regarding to claim 11, Kaschke teaches a cellular portable radiotelephone comprising: a processor; a static random access memory coupled to the processor; and a transceiver having an antennae module, wherein at least a portion of the antennae unit extends from the transceiver in a first position to enable the communication module to transmit and receive (see Fig. 4 and col. 9, lines 32-48, and col. 5 lines 2-5) and wherein the portion retracts into the communication module in a second position to disable the communication module from transmitting or receiving (see Fig. 3A- C and col. col. 4, lines 5-14, co. 5 lines 14-19 and col. 6, lines 15-41).

Regarding to claim 12, Kaschke teaches wherein at least a majority of the antennae unit extends from the communication module when the antennae unit is in the first position (extended) (see Fig. 3A-B, the extended position 313 or 314).

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Regarding to claim 13, Kaschke teaches wherein the antennae unit disables the communication module when in a second position (see Fig. 3A- C and col. col. 4, lines 5-14, co. 5 lines 14-19).

Regarding to claim 14, Kaschke teaches wherein at least a majority of the antennae unit is contained within the communication module when in the second position (see fig. 3A-B, of 307 position).

Regarding to claim 15, Kaschke teaches wherein the antennae unit extends less than about 10 centimeters outward from the communication module when in the first position (see fig. 3B position 307).

Regarding to claim 16, Kaschke teaches wherein the antennae unit is adapted to enable a visual indicator when in the second position (see fig. 5 and col. 10, lines 24-26, col. 12, lines 64-66, col. 13, lines 22-26 and lines 45-47, col. 17 lines 13-23).

Regarding to claim 17, Kaschke teaches a method comprising: disabling a communication module in a portable device by inserting at least a portion of an antennae unit into the communication module (see Fig. 5, col. 2 lines 62-67, col. 3, lines 1-6, col. 4, lines 5-14 and col. 6, lines 15-41).

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Regarding to claim 18, Kaschke teaches wherein disabling the communication module includes moving at least a majority of the antennae unit into the communication module (see Fig. 5, col. 2 lines 62-67, col. 3, lines 1-6 and col. 4, lines 5-14).

Regarding to claim 19, Kaschke teaches enabling the communication module by extracting at least a majority of the antennae unit from the communication module (see Fig. 3 A-C, and col. 4, lines 5-14).

Regarding to claim 20, Kaschke teaches further comprising enabling a visual indicator with disabling the communication by retracted antennae unit (see fig. 5 and col. 10, lines 24-26, col. 12, lines 64-66, col. 13, lines 22-26 and lines 45-47, col. 17 lines 13-23).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Usui (U.S. Patent No. 6,336,039) in view of Kaschke (U.S. Patent no. 5,898,933).

Regarding to claim 1, Usui teaches an apparatus (Fig. 5, item 2 PC) comprising:

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a communication module (Fig. 5 item 12) having an antennae unit (Fig. 5 item 13), (see Figs. 5, 6, 8 and 10). But Usui fails to show the antennae unit is adapted to disable the communication module when in a first position.

However, Kaschke teaches a radiotelephone having a moveable antenna, an apparatus and method generates a control signal or responsive to the position of the antenna, and operating mode of the radiotelephone can be disabled responsive to the hook switch control signal by retracting the antenna to first position (see Fig. 5, col. 2 lines 62-67, col. 3, lines 1-6, col. 4, lines 5-14 and col. 6, lines 15-41).

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Usui system and the providing of the teaching of Kaschke with the moveable antenna unit for disable/enable the transmitter thereto in order to provide the convenient for user operation and protection from accidental activation of exposed control keys.

Regarding to claim 2, Kaschke teaches wherein the apparatus is operational when the antenna unit is in the first position (retracted) (see col. 4 lines 61-63, col. 5, lines 14-30).

Regarding to claim 3, Kaschke teaches the slave microprocessor store the status of the hook switch and provides an indication of the changes of state of the hook switch to enable the microcomputer system and determination is made whether the antenna is extended or retracted and the slave microprocessor is enable a visual indicators (see fig. 5 and col. 10, lines 24-26, col. 12, lines 64-66, col. 13, lines 22-26 and lines 45-47, col. 17 lines 13-23).

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Regarding to claim 4, Kaschke teaches wherein the visual indicator comprises a light emitting diode (LED) (see Fig. 5 LED, and col. 10, lines 24-29).

Regarding to claim 5, Kaschke teaches wherein the antenna unit is further adapted to enable the portable radiotelephone communication when in a second position (extended) (see fig. 8, col. 4, lines 5-14).

Regarding to claim 6, Kaschke teaches wherein at least a majority of the antenna unit is contained within the radiotelephone when in the first position (see fig. 3 A and col. 4 lines 31-32).

Regarding to claim 7, Kaschke teaches wherein substantially all of the antenna unit is contained within the communication module when in the first position (see fig. 3 A and col. 4, lines 33-35).

Regarding to claim 8, Usui and Kaschke teach wherein the communication module comprises a radio (see Usui fig. 8 item 222 and Kaschke fig. 4, radio transceiver 402).

Regarding to claim 9, Kaschke teaches a portable radiotelephone adapted use in a cellular radiotelephone system to transmit and receive signals having a frequency ranging of cellular band from about 1 MHz to 900 MHz (see fig. 2, and col. 3, lines 51-52 and lines 64-67).

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Regarding to claim 10. Usui teaches wherein the communication module comprises a personal computer memory card international association (PCMCIA) card (see fig. 5 item 31 IC, card and fig. 8 JEIDA card for cell unit 16, col. 2 lines 2-36).

### ***Response to Arguments***

5. Applicant's arguments filed 06-14-2004 have been fully considered but they are not persuasive.

#### ***Response to Arguments:***

Applicant argues the reference of Kaschke does not teach the retracting the antenna 213 of the antenna module 325 is not disabling the communication module by operation mode of transmitter. However the examiner does not agree. Since the Control functions related to the mode of operation of the portable radiotelephone 325 may be disabled to prevent accidental operation when the antenna 213 is in it's retracted position at 313, i.e., when the portable radiotelephone 325 is not in use, and may be enabled when the antenna 213 is in its extended position at 314, i.e., when the portable radiotelephone 325 is in use, the retracting the antenna 213 on the portable radiotelephone 200 may disable user interface controls, either on the keypad 205 or on other peripheral surfaces of the radiotelephone 325, such as the "on/off" 508, number dialing 517, volume controls 207' and 209', "send" 513, "end" 515, "clear" 521, "function" 523 and memory store 525 and recall 527 controls. Additionally, a retracted antenna at 313 may disable circuitry such as voice recognition circuitry as shown in FIG. 6A and hands-free circuitry as shown in FIG. 6B. Extending the antenna 213 enables the aforementioned disabled control functions and circuitry as well as keypad illumination 536-541



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and display circuitry 211' per FIG. 5 (see fig. 5, col. 6, lines 15-41). Therefore the retracting the antenna 213 of the antenna module 325 is disabling the communication module by operation mode of transmitter and receiver is read on the Kaschke reference.

Applicant argues there is no motivation to combine of the reference of Kaschke and Usui. Examiner does not agree, Sine the reference of Kaschke teaches the moveable antenna unit for disable/enable the transmitter that method provides convenient user operation (see Kaschke col. 3, lines 5-6).

Applicant also argues there is no motivation to combine the reference of Kaschke with Usui for protection from accidental active of the exposed control key, and it is not suffer from the problem of the accidental activation, because the device does not have any exposed keys or control button. The examiner also does not agree. Since Usui teaches the portable phone 222 it has the dial button 121 (see Usui, fig. 6, dial button 121) and Kaschke teaches the protection from accidental activation of an exposed user key (see Kaschke, col. 3, lines 6-7). Therefore, there is a motivation for combining the references.

**6. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

*Conclusion*

**6. Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

**(703) 872-9314, (for Technology Center 2600 only)**

*Hand-delivered responses should be brought to Crystal Park II,  
2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tan Trinh whose telephone number is (703) 305-5622. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung, can be reached at (703) 308-7745.


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The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Technology Center 2600 Customer Service Office** whose telephone number is **(703) 306-0377**.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tan H. Trinh   
Art Unit 2684  
August 19, 2004

 8/21/04

QUOCHIEN B. VUONG  
PRIMARY EXAMINER